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Entered 25 February 2008

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JAY M. **SHORT**

Junior Party
(Patent 6,605,449),

v.

PHILLIP A. **PATTEN**,
and WILLEM P.C. STEMMER,

Senior Party
(Application 10/646,221).

Patent Interference No. 105,532
(Technology Center 1600)

Before: FRED E. McKELVEY, *Senior Administrative Patent Judge*, and RICHARD TORCZON and SALLY GARDNER LANE, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

Judgment – Priority – Bd. R. 127(a)

Short had indicated that it will not contest priority. (Paper 20 at 2). Each of the threshold motions filed by Short (Bd. R. 201) has been denied. (Paper 63). Judgment on priority shall be entered against Short.

Upon consideration of the record and for reasons given, it is

ORDERED that judgment on priority as to Count 1, the sole count of the interference, is entered against junior party Short;

FURTHER ORDERED that claims 1-12 of Short patent 6,605,449, which claims correspond to Count 1 (Paper 1 at 4), are CANCELLED (35 U.S.C. § 135(a));

FURTHER ORDERED that the parties note the requirements of 35 U.S.C. § 135(c) and Bd.R. 205;

RECOMMENDED (see Bd. R. 127(c)) that, upon the return of the Patten application to *ex parte* prosecution, the Examiner consider the references cited by Short and any issues of patentability raised by Short, in the Short Motions List (Paper 17); and

FURTHER ORDERED that a copy of this judgment, a copy of the decision on the Short motions (Paper 63), and a copy of the Short motion list (Paper 17) shall be entered into the administrative record of Short patent 6,605,449 and Patten application 10/646,221.

cc (via electronic filing):

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Paper No. _____

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PHILLIP A. **PATTEN**
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(U.S. Application No. 10/646,221).

Patent Interference No. 105,532 (SGL)
(Technology Center 1600)

PATTEN LIST OF PROPOSED MOTIONS

MAIL STOP INTERFERENCE
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
600 Dulany Street, 9th Floor
Madison Building East
Alexandria, Virginia 22314

Your Honor:

Pursuant to Part D of the Declaration of Interference mailed February 14, 2007 (Paper No. 1, Page 2), 37 C.F.R. §§ 41.120 and 41.204(b), and ¶¶ 104.2.1, 120, and 204 of the Standing Order, and as presently advised, Senior Party Patten ("Patten") hereby advises the Board that it reasonably anticipates filing the following motions:

I. SUBSTANTIVE MOTIONS

Unpatentability – Prior Art

1. Claims 1-12: § 102(b)/103 Over WO 96/40968

Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(1), and Standing Order ¶ 208.1, on the basis that Claims 1-12 of U.S. Patent No. 6,605,449 ("the '449 patent"), are not patentable to Junior Party Short under 35 U.S.C. § 102(b) and/or 35 U.S.C. § 103 in light of International Patent Publication WO 96/40968 (published on December 19, 1996).

2. Claims 2 and 10: § 103 Over WO 96/40968 in View of WO 97/48717 and 97/20078, Respectively

Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(1), and Standing Order ¶ 208.1, on the basis that Claim 2 of the '449 patent is not patentable to Short under 35 U.S.C. § 103 in light of International Patent Publication WO 96/40968 (published on December 19, 1996) in view of International Patent Publication WO 97/48717 (published on December 24, 1997); and on the basis that Claim 10 of the '449 patent is not patentable to Short under 35 U.S.C. § 103 in light of International Patent Publication WO 96/40968 (published on December 19, 1996) in view of International Patent Publication WO 97/20078 (published on June 5, 1997).

3. Claims 1, 6, 9, 11 and 12: § 102(b)/103 Over WO 98/05765

Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(1), and Standing Order ¶ 208.1, on the basis that Claims 1, 6, 9, 11, and 12 of the '449 patent are not patentable to Short under 35 U.S.C. § 102(b) and/or 35 U.S.C. § 103 in light of International Patent Publication WO 98/05765 (published on February 12, 1998).

4. Claim 2: § 103 Over WO 98/05765 in View of WO 97/48717
Claims 3-5, 7-8: § 103 Over WO 98/05765 in View of WO 96/40968
Claim 10: § 103 Over WO 98/05765 in View of WO 97/20078

Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(1), and Standing Order ¶ 208.1, on the basis that Claim 2 of the '449 patent is not patentable to Short under 35 U.S.C. § 103 in light of International Patent Publication WO 98/05765 (published on February 12, 1998) in view of International Patent Publication WO 97/48717 (published on December 24, 1997); and on the basis that Claims 3-5, and 7-8 of the '449 patent are not patentable to Short under 35 U.S.C. § 103 in light of WO 98/05765 (published on February 12, 1998) in view of International Patent Publication WO 96/40968 (published on December 19, 1996); and on the basis that Claim 10 of the '449 patent is not patentable to Short under 35 U.S.C. § 103 in light of WO 98/05765 (published February 12, 1998) in view of International Patent Publication WO 97/20078 (published on June 5, 1997).

5. Claims 1-12: § 102(a) Over WO 98/27230
Claims 1-3, 6, 9, 11 and 12: § 102(e) Over USPN 6,917,882
Claims 4, 5, 7, 8, 10: § 103 Over USPN 6,917,882 Optionally in View of WO 98/27230

Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(1), and Standing Order ¶ 208.1, on the basis that: (A) Claims 1-12 of the '449 patent are not patentable to Short under 35 U.S.C. § 102(a) in light of International Patent Publication WO 98/27230 (published on June 25, 1998); (B) Claims 1-3, 6, 9, 11, and 12 of the '449 patent are not patentable to Short under 35 U.S.C. § 102(e) in light of U.S. Patent No. 6,917,882 (filed January 18, 2000, which claims priority to, *inter alia*, January 19, 1999, which issued on July 12, 2005); and (C) Claims 4, 5, 7, 8, and 10 are not patentable under 35 U.S.C. § 103 in light of U.S. Patent No. 6,917,882 alone, or optionally in view of WO 98/27230.

Unpatentability – Indefiniteness

6. Claims 8 and 12: § 112, Second Paragraph – "polyketide"

Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(1), and Standing Order ¶ 208.1, on the basis that Claims 8 and 12 of the '449 patent are not patentable to Short under 35 U.S.C. § 112, Second Paragraph, for failing to satisfy the definiteness requirement. Claim 8 of the '449 patent is indefinite at least because a polyketide is not a protein or polypeptide. There are no polynucleotides that encode a polyketide. Claim 12 of the '449 patent is indefinite at least because "step of (c)" has no antecedent basis in Claim 1.

Unpatentability – Enablement

7. Claims 1-12: § 112, First Paragraph – *e.g.*, "progenitor nucleic acid sequences"

Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(1), and Standing Order ¶ 208.1, on the basis that Claims 1-12 of the '449 patent are not patentable to Short under

35 U.S.C. § 112, First Paragraph, for failing to satisfy the enablement requirement. For example, the term "progenitor nucleic acid sequences" in Claim 1 of the '449 patent includes a plurality of identical sequences because there is no limitation that the progenitor nucleic acid sequences differ from each other in sequence. The plural "sequences" can be read to indicate two identical sequences. The '449 patent does not teach one of skill in the art how to obtain a "library" of progeny sequences from progenitor sequences that are identical to each other, especially since recombinants of two identical sequences will all be identical. In addition, the term "progenitor nucleic acid sequences" in Claim 1 of the '449 patent is overbroad because it includes sequences that do not have areas of homology and because it includes sequences having as few as two nucleotides. The '449 patent does not teach one of skill in the art how to align such sequences nor how to determine demarcation points in such sequences in order to generate a plurality of pre-determined building block sequences.

Redefine the Scope of the Interference – Substitute Count 1 with Count 2

8. Motion under 37 C.F.R. §§ 41.121(a)(1)(i) and 41.208(a)(2) seeking to redefine the scope of the interference by substituting Count 2 for Count 1. Specifically, Patten asserts that Count 2, an alternative count consisting of Claim 6 of the '449 patent OR Claim 275 of Patten's involved U.S. Patent Application Serial No. 10/646,221 ("the '221 application"), should be substituted for Count 1. Claim 1 should not be part of a Count because it is not patentable, at least for the reasons above, and because Claim 1 is not patentable under 35 U.S.C. § 101 because it lacks utility. Claim 1 lacks utility because there is no requirement that the progenitor or progeny sequences encode a molecule having any function or property.

Priority

9. Motion for Judgment under 37 C.F.R. §§ 41.121(a)(1)(iii) and 41.208(a)(4) seeking judgment in favor of Patten on priority.

II. RESPONSIVE MOTIONS

10. If Short files one or more Motions pursuant to 37 C.F.R. §§ 41.121(a)(1)(iii) and Standing Order ¶ 208.1 for Judgment that Patten claims are not patentable under any of 35 U.S.C. §§ 102, 103, and/or 112, then Patten may request permission to file one or more appropriate responsive motions pursuant to 37 C.F.R. §§ 41.121(a)(2), as needed.

Respectfully submitted,

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